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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,460	04/29/2002	Juergen Lorenz	125931-00104	4081
64574	7590	06/19/2008		
BLANK ROME LLP ONE LOGAN SQUARE PHILADELPHIA, PA 19103			EXAMINER HAIDER, SAIRA BANO	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			06/19/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/009,460

**Applicant(s)**

LORENZ ET AL.

**Examiner**

SAIRA HAIDER

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-19 and 22-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 14-19 and 22-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The rejections have been maintained and the response to arguments is provided below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/9/2008 has been entered.

#### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 14-18, 22-23, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Czerwinski et al. as evidenced by both Hawley's (Polyvinyl Acetate article) and Skoog et al. (US 2007/0134408).
5. The reference teaches thixotropic compositions comprising a liquid material and leather fibers (col. 2 lines 20-22), where polyvinyl acetate and other thermoplastics are taught as liquid coating composition binders (col. 5, lines 21-35). The binders are used in amounts of 1-95% by weight, while the leather fibers are used in amounts up to about 20% by weight (col. 5, lines 36-50). The reference also teaches the claimed fibers lengths (table, col. 12).
6. It is noted that polyvinyl acetate is recognized by Hawley's as a thermoplastic polymer. Further, it is noted that polyvinyl acetate is recognized by applicants as a polyvinyl ester (Specification, page 8, lines 15-16). It is noted that the prior art's disclosure of about 20% by weight of the fibers anticipates the claimed 20% by weight.

7. It is noted that a solvent (or liquid carrier) is present in the composition of Czerwinski. However, post application of the composition of Czerwinski the solvent is removed (via evaporation), thus resulting in a hardened composite material, as claimed. Support is provided by the fact that Czerwinski recognizes the usage of volatile vaporizable organic solvents (such as acetone), which do not copolymerize with the resin, thus are not incorporated into the final solid composition (col. 4, lines 51-58). Further, the incentive to utilize a thixotropic composition is for ease of application as recognized by Czerwinski via disclosure of a variety of compositions which are thixotropic upon application and hardened post application, including coatings, adhesives, sealants, and the like (col. 3, lines 44-55). Wherein coatings, adhesives and sealants are recognized in the art as hardened in the final state, and capable of withstanding applied shear forces. Specifically, this well recognized fact is evidenced by Skoog et al. which discloses thixotropic coatings wherein the thixotropic property allows for improved application and the ability to work the coating. Wherein Skoog recognizes that during the drying period the solvent evaporates to form a coating [0012]. Skoog recognizes acetone as an evaporatable solvent [0034]. Accordingly, it is clear that post application of the thixotropic composition of Czerwinski the solvent is removed (via evaporation), thus resulting in a hardened composite material, as claimed.

8. Thus, the examiner has presented reasoning tending to show inherency, wherein the composition of the reference appears to be substantially identical to that claimed. The burden shifts to the applicant to show an unobvious different. "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on '*prima facie* obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims.

*In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski, as applied above, in view of Moran (US 4882373).
11. The disclosure of Czerwinski is provided above. Czerwinski provides broad disclosure of suitable thermoplastic compositions including cellulose acetate and polyvinyl chloride (col. 5, lines 21-29). However, Czerwinski fails to expressly disclose that the composition includes a thermoplastic binder comprised of a copolymer of butadiene and styrene. Hence attention is drawn towards the Moran reference. Moran discloses an asphaltic composition comprising a thermoplastic elastomer (abstract). Specifically, Moran discloses that the asphaltic compositions can be used in additional applications, such as roofing sheets, adhesives and coatings (col. 1, lines 55-62). Czerwinski is considered analogous art to Moran because Czerwinski's composition can be utilized as asphalts (col. 3, lines 44-51). Hence both references drawn to the same field of endeavor.
12. Moran discloses that a way to decrease asphalt's tendency to soften and creep at high temperatures (as well as to improve its low temperature flexibility and solid-like properties) is to add thermoplastic elastomers such as styrene-butadiene-styrene ("SBS") block copolymers. The addition of such polymers serve to modify asphalt for additional applications, such as roofing sheets, adhesives and coatings (col. 1, lines 55-62). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include a styrene-butadiene copolymer in the invention of Czerwinski in order to decrease the resulting asphalt based product's tendency to soften and

creep at high temperatures, as well as to improve its low temperature flexibility and solid-like properties. Hence Czerwinski would look towards the teachings of Moran to improve the compositions. Wherein the total amount of thermoplastic binder in the composition of Czerwinski would include the amount of styrene-butadiene copolymer added.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski et al. in view of K  chler et al.

14. Czerwinski applies as above, teaching thermoplastic compositions useful as coatings and films but failing to teach the claimed manufacture process including the treatment, dewatering, and drying steps. K  chler teaches aqueous plastic dispersions of vinyl polymers and filler, where the filler comprises fibrous material (abstract). Preferred fibers include leather fibers (col. 3 lines 20-36). The reference teaches a process of adding fibers to a plastic dispersion, treating the dispersion with aluminum sulfate in an additive amount of 5-20% by weight, removing the water, and drying the mixture to form a sheet (col. 3 line 52-col. 4 line 13). This process is used to form sheets of vibration-damping properties. Thus, it is the examiner's position that it would have been prima facie obvious to employ the methods of K  chler's invention to form materials with improved vibration damping properties.

15. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski et al. in view of Toyota.

16. Czerwinski applies as above for the making of leather products, failing to mention the use of hot-melt films to form leather laminates. Toyota teaches a method of bonding leather to a backing material via a hot-melt adhesive to form seating articles having improved mechanical strength

(abstract). The molten adhesive would inherently form a film between the two outer layers. It is the examiner's position that it would have been prima facie obvious to use Toyota's article-forming method to form leather articles having improved appearance while having improved mechanical strength.

17. Claims 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski et al.

18. Czerwinski applies as discussed above and discloses that the leather fibers are present in an amount of about 1%-20% by weight of the composition. Accordingly, Czerwinski fails to disclose the claimed 25-45% by weight of leather fibers. However, it is noted that Czerwinski recognizes the leather fibers as the thixotropic agent in the composition, meaning, the leather fibers cause the formation of the thixotropic gel composition (col. 5, lines 36-50; claim 1). It is the examiner's position that the amount of leather fibers (i.e. thixotropic agent) in the composition is a result effective variable because changing the concentration will clearly affect the type of product obtained. Wherein an increase in the concentration of leather fibers in the composition above about 20% will result in an increase in the viscosity and increase in the thixotropic properties (i.e. variation in the amount of force required to change the composition from a liquid to a gel). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the leather fibers in a concentration greater than 20%, such as 30% or 40% in order to produce the desired end results. Case law holds that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

19. Additionally, MPEP § 2144.05, hold that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence

indicated such a concentration is critical. Where general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%). Given that the herein applied prior art references disclose the general conditions of the claim, it is the examiner's position that it is not inventive to discover the optimum or workable ranges by routine experimentation. Further, in the *In re Aller* case, the percent difference in the acid concentration of the prior art (10%) and claim (25%) was 60%, in the instance case, the percent difference in the leather fiber concentration of the prior art (20%) and the claim (25%) is 20%. Thus, since the claimed acid value of 25% was held of be *prima facie* obvious over a prior art disclosure of 10%, it is clear that the herein claimed leather fiber concentration of 25% is *prima facie* obvious over the prior art disclosure of 20%.

### ***Response to Arguments***

20. Applicant has argued that polyvinyl acetate is no a member of the group that defines the thermoplastic binder in component (b) of claim 14. As noted in the rejection above, the instant specification recognizes polyvinyl acetate as a polyvinyl ester, wherein polyvinyl ester is explicitly recited in component (b) of claim 14 (Specification, page 8, lines 15-16).

21. Applicant has argued the inherency argument regarding solvent removal in the hardened thixotropic composition. As noted in the rejection above, the examiner has provided a reference which establishes that upon application of thixotropic compositions the solvent evaporates and the composition hardens. Given that the examiner has established the basis of inherency, the burden



shifts to the applicant to show an unobvious different. In the absence of any showings provided by applicant, the rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIRA HAIDER whose telephone number is (571)272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796

Saira Haider  
Examiner  
Art Unit 1796